

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1 and 3-5 are pending, claim 1 being independent. Claim 2 has been canceled without prejudice or disclaimer and independent claim 1 has been amended to incorporate subject matter from canceled claim 2 and to include some subject matter suggested by the Examiner. Claims 4 and 5 have been amended to be consistent with claim 1 amendments and the cancellation of claim 2.

Interview

Applicant thanks the Examiner for scheduling a personal interview with applicant's representative on August 12, 2008. During this interview several possible modifications were discussed as to claim 1. These discussions focused first on modifying claim 1 to indicate that the previously recited "property information" were --property information items--. While the Examiner acknowledged that this change was a step in the right direction, he further pointed out that this language was still considered to be too broad and in need of further narrowing to eliminate being read on image information in a generic sense (i.e., as any property information). A discussion then followed of possible narrowing limitations to add to the "items," such as designation as to the photographer who took the photograph or color properties of the photograph, for example.

In addition to discussing different specific types of property information items that might (e.g., photographer, color properties) or might not (e.g., date photograph made) be considered to impart patentability, the Examiner noted a need for fuller clarity as to the source for various claim 1 recitals. For example, the Examiner noted that the claim 1 "security processing method setting means" should be modified to specifically indicate that the "items" were obtained from the previously recited claim 1 "property information obtaining means." The Examiner further suggested that a similar approach should be used throughout claim 1.

After reviewing the present claims and considering the suggested additions as to "items," applicant has decided that specifying only limited types of information is too narrow and that it misses the point that the invention is concerned with providing an approach to decide what items

of the property information will be attached to the image data set in the first place. It is also concerned with providing access to items of the property information that are not attached to the image data set along with access to the image data set with attached property information. Accordingly the suggested naming of specific items that are attached to the data image set has not been adopted.

In order to present the above noted concern as to deciding on the attachment of items to a data image set and providing access to all items whether or not they are attached to a data image set, claim 1 is now amended to essentially incorporate the subject matter from claim 2. Claim 2 is, accordingly, canceled. In addition, the Examiner's suggestion as to indicating the source of the claim elements that are undergoing further processing has been adopted as to the further changes made to claim 1.

Prior Art Rejection

Claims 1-5 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent 6,473,859 to Enokida (hereinafter "Enokida"). This rejection is respectfully traversed.

As claim 2 has been canceled, the rejection thereof on this ground is submitted to be moot. In addition, the subject matter incorporated into claim 1 from claim 2 is discussed below.

With regard to independent claim 1 and claims 3-5 that depend from claim 1, it is noted that the mere assertion in the outstanding Action that the teachings of Enokida in some unexplained manner encompass "the claim limitations as broadly interpreted by the examiner" is not reasoning that can be relied upon to reject "means-plus-function" limitations.

According to the binding decision of *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994):

Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination. (Emphasis added).

As further explained in MPEP §2182, in order to comply with this precedent, "the first step in construing a means-plus-function claim limitation is to define the particular function of the claim

limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 [58 USPQ2d 1801, 1806] (Fed. Cir. 2001). ‘The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations.’ *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113 [63 USPQ2d 1725, 1730] (Fed. Cir. 2002)... The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function.” Further note the similar requirements set forth by *Gechter v. Davidson*, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997). The above-noted Federal Circuit decisions require the PTO to construe the claimed functions and to “look to the specification and identify the corresponding structure for that function” as well as to explain how the portion of Enokida relied on in the rejection teaches that function and the corresponding structure related thereto as well as the equivalents of this corresponding structure.

Instead of following the dictates of the Federal Circuit decisions and the requirements of 37 CFR §1.104(c)(2) (as to designating the particular parts of Enokida that are being relied upon “as nearly as practicable”), the outstanding Action makes an all encompassing reference to the abstract and all the figures (1-11) of Enokida, including the associated descriptions thereof, and to col. 1, lines 46-67 that merely set forth objects of the invention of Enokida as to the subject matter of claim 2 that has been incorporated into claim 1.

To whatever extent that col. 1, lines 60-67 of Enokida teach an image processing apparatus that has coding means for converting image data into hierarchical coded data and encryption means for encrypting a predetermined hierarchy among the hierarchical coded data with the adding of a code to the encrypted hierarchy for causing a part of a process for decoding the hierarchical coded data to be skipped, this has nothing to do with the means and corresponding functions of amended claim 1, and particularly not the limitations from canceled claim 2 that now appear in claim 1. Note, for example, that the subject matter of amended claim 1 now requires an “attachment decision means for deciding that first ones of the items of the property information are to be attached to the image data set” and as well as the recited “attaching means” that then attaches “the first ones of the items of the property information decided by the attachment decision means to the image data set.” In addition, amended claim 1 requires both an “image data storage means for storing the image data set attached with the first

ones of the items of the property information by the attachment means" and a "property information storage means for storing remaining items of the property information not attached to the image data set by the attachment means in a manner to permit access thereof with a corresponding image data set with attached property information."

As noted in the paragraph bridging pages 7 and 8 of the specification, these separate storage elements and the attachment of only selected ones of the different property information items for attachment and storage with the image data set provides the advantage that download times can be shortened. No such functions and corresponding structure are present in Enokida and Enokida cannot be said to anticipate the subject matter of amended claim 1.

At least in view of the above, Applicant respectfully submits that Enokida fails to anticipate claim 1, or any claim depending there from. Accordingly, the withdrawal of the rejection of claims 1 and 3-5 under 35 U.S.C. §102(b) as being anticipated by Enokida is respectfully requested.

Conclusion

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond Cardillo, Reg. No. 40,440, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,


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